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24 APPLE INC.

25 UNILOC USA, INC. and
26 UNILOC LUXEMBOURG, S.A.,

27 Plaintiffs,

v.

28 APPLE INC.,

Defendant.

Case No.: 4:19-cv-01693-JST

**JOINT STATUS REPORT AND JOINT
STIPULATION WITH [PROPOSED]
ORDER TO STAY CASE PENDING
APPEALS**

29 Plaintiffs Uniloc USA, Inc. and Uniloc Luxembourg, S.A. (collectively “Uniloc”) and
30 Apple Inc. (“Apple”) jointly file this status report and stipulation to stay pending appeal of other
31 relevant cases.

32 **Status Report**

33 On May 30, 2018, Uniloc filed a First Amended Complaint asserting infringement by
34 Apple of U.S. Patent No. 7,167,487 (“the ’487 patent”). Dkt. No. 32. This Joint Status Report is
35 submitted pursuant to the June 13, 2019, Stipulation with Order Staying Case Pending Resolution
36 of *Inter Partes* Review Proceedings, Dkt. No. 66, and the Order Extending Stay, Dkt. No. 71. As
37 noted therein, Defendant Apple (among others) filed two petitions for *inter partes* review of the
38 ’487 Patent—IPR2019-00222 and IPR2019-00252—both of which were instituted.

On May 19, 2020, the PTAB issued a Final Written Decision in IPR2019-00222, holding claims 1-6 of the '487 Patent unpatentable. The same day, the PTAB issued a Final Written Decision in IPR2019-00252, holding claims 11-13 of the '487 Patent unpatentable.

Uniloc filed its notice of appeals as to both Final Written Decisions. On January 6, 2021, pursuant to Uniloc’s request to voluntarily dismiss the appeals, the Federal Circuit dismissed both appeals.

Thus, claims 1-6 and 11-13 have been found and remain unpatentable.

Uniloc's Statement: Uniloc has advised Apple it is asserting all claims of the '487 patent, except those that the PTAB has invalidated. This would include claims 7-10, as will be set forth in Uniloc's infringement contentions.

Apple's Statement: Uniloc's May 30, 2018 First Amended Complaint only asserted claims 1, 3, 5-6 and 12 of the '487 patent. All asserted claims have now been invalidated. Uniloc has no good faith basis to maintain this lawsuit against Apple.

Stipulation to Stay

THE PARTIES STIPULATE to stay this action, pending appeal of this District's decision regarding the Uniloc entities' lack of standing in *Uniloc 2017 LLC v. Google LLC* (Case No. 20-4355 and various related cases); this District's decision regarding Uniloc USA, Inc.'s and Uniloc Luxembourg S.A.'s lack of standing in *Uniloc USA, Inc. et al v. Apple Inc.* (Case No. 18-358); and the District of Delaware's decision regarding Uniloc USA, Inc.'s and Uniloc Luxembourg S.A.'s lack of standing in *Uniloc USA, Inc. et al. v. Motorola Mobility LLC* (Case No. 17-1658).

Those courts held that a third party had the ability to sublicense the patents in the Uniloc portfolio as of the dates those actions were filed; that that ability deprived the Uniloc plaintiffs of constitutional standing to file the actions; and that the court therefor did not have subject matter jurisdiction. As a result, those courts dismissed the actions, and the Uniloc plaintiffs from those cases have filed appeals as those decisions.

Because those decisions appear to create issue preclusion as to various factual and legal issues in this action, and that preclusion may cause this Court to lack subject matter jurisdiction

1 over this action, the parties believe the Court cannot proceed until the Federal Circuit resolves
2 those issues.

3 The parties therefor STIPULATE, with the consent of the Court, to stay this action until
4 the last of such decisions on the above appeals by the United States Court of Appeals for the
5 Federal Circuit.

6 Date: February 1, 2021

Respectfully submitted,

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ATTESTATION OF FILER

I hereby attest that all other signatories listed, and on whose behalf the filing is submitted, concur in the filing's content and have authorized the filing.

/s/ Aaron S. Jacobs